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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,052	03/31/2004	Haifeng Bi	P24836	4859

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EXAMINER

HARPER, KEVIN C

ART UNIT PAPER NUMBER

2666

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,052

Applicant(s)

BI ET AL

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☒ Claim(s) 26 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.11.12/04: 6/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-20 and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-35 of U.S. Patent No. 6,757,278 in view of Elliot et al. (US 2004/0022237).

1. Regarding claims 16-20 and 24, claims 33-35 of the '278 patent each recites a ATM system comprising a CS-IWF device, where the CS-IWF device and T-IWF devices provide communications only when members of a closed user group. However, claims 33-35 additionally recite end office switches. In removing additional limitations, the scope of the claims is merely broadened by eliminating elements and their functions. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite end office switches in the '278 patent. Further, claims 33-35 of the '278 patent does not recite a signaling transfer point of an

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advanced intelligent network. Elliot discloses an ATM system in communication with an advanced intelligent network having signaling transfer points (fig. 2A; para. 600, line 6) that communicate SS7 common channel signaling (abstract). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have an advanced intelligent network having signaling transfer points in the '278 patent in order to interconnect end offices that provide advanced intelligent network features. Further regarding claims 18-20, broadband signaling recited in each of claims 33-35 is in-band signaling packets as communicated in an ATM network and UNI having standardized signaling is recited in claims 33-35.

2. Regarding claim 23, claims 33-35 of the '278 patent do not disclose that the CS-IWF device serves a metropolitan area. Elliot discloses a CS-IWF device (fig. 2A, item 104; para. 458) that serves a metropolitan area (para. 1019-1020 and 1023). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a CS-IWF device serve a metropolitan area in the '278 patent in order to interconnect calls over a large backbone network.

Claims 16, 21 and 24-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,757,278 in view of Elliot et al. (US 2004/0022237).

3. Regarding claims 16, 20 and 24-25, claim 19 of the '278 patent each recites a ATM system comprising a CS-IWF device, where the CS-IWF device and T-IWF devices provide communications only when members of a closed user group. A management system receives and stores a list by identifying the members of the closed user group. However, claim 19 additionally recites preventing transmission to devices outside the closed user group. In

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removing additional limitations, the scope of the claims is merely broadened by eliminating elements and their functions. It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to not recite preventing transmission of data to devices outside the closed user group in the '278 patent. Further, claim 19 of the '278 patent does not recite a signaling transfer point of an advanced intelligent network. Elliot discloses an ATM system in communication with an advanced intelligent network having signaling transfer points (fig. 2A; para. 600, line 6) that communicate SS7 common channel signaling (abstract). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have an advanced intelligent network having signaling transfer points in the '278 patent in order to interconnect end offices that provide advanced intelligent network features.

Claims 22 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33-35 of U.S. Patent No. 6,757,278 in view of Elliott et al, as applied to claim 16 above, in further view of Dobbins et al. (US 5,684,800).

4. Claims 33-35 of the '278 patent do not recite a CS-IWF device belonging to more than one closed user group. Dobbins discloses a device that belongs to more than one closed user group (fig. 5, items 20B, 20D and 20H). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a device belong to more than one closed user group in the '278 patent in order to flexibly provide associations for devices within the network.

Allowable Subject Matter

5. Claims 1-15 are allowed.
6. Claims 16-25 would be allowable if the above double patenting rejection is overcome.
7. Claim 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hall, Jr. et al. (US 2002/0061101) discloses an ATM network for providing narrowband call interfacing (fig. 1) where the end users are members of closed user groups (fig. 5, steps 504 and 506).

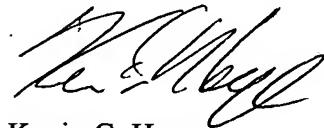
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 571-272-3166. The examiner can normally be reached weekdays from 11:00 AM to 7:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 571-272-3174. The centralized fax number for the Patent Office is 571-273-8300. For non-official communications, the examiner's personal fax number is 571-273-3166 and the examiner's e-mail address is kevin.harper@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications associated with a customer number is available through Private PAIR only. For more information about the PAIR system, see portal.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Kevin C. Harper", is positioned above the printed name.

Kevin C. Harper

July 10, 2005